

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Cristian Constantino

Serial No. 10/606,687

Filed: 06/26/2003

For: **EMERGENCY SERVICES FOR PACKET NETWORKS**

Examiner: Quynh H. Nguyen

Art Unit: 2614

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith. The Appellant encloses a payment in the amount of \$670.00 as required by 37 C.F.R. § 1.17(c) and to cover the fee associated with a One-month Extension of Time. If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 14-1315, and consider this a petition therefor.

**APPEAL BRIEF**

**(1) REAL PARTY IN INTEREST**

The real party in interest is the assignee of record, i.e., Nortel Networks Limited of 2351 Boulevard Alfred-Nobel, St. Laurent, Quebec Canada H4S 2A9, which is wholly owned by Nortel Networks Corporation, a Canadian corporation.

**(2) RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences to the best of the Appellant's knowledge.

**(3) STATUS OF CLAIMS**

Claims 1-35 were rejected with the rejection made final on September 9, 2008.

Claims 1-35 are pending and are the subject of this appeal.

**(4) STATUS OF AMENDMENTS**

All amendments have been entered to the best of the Appellant's knowledge. No amendments have been filed after the Final Office Action mailed September 9, 2008.

## **(5) SUMMARY OF CLAIMED SUBJECT MATTER**

In the following summary, the Appellant has noted where in the Specification certain subject matter exists. The Appellant wishes to point out that these citations are for demonstrative purposes only and that the Specification may include additional discussion of the various elements, citations to which are not pointed out below. Thus, the noted citations are in no way intended to limit the scope of the pending claims.

Independent claim 1 recites a method for controlling access to emergency services comprising:

- a) receiving call setup requests from at least one originating device (Specification, paragraphs 0014, 0022, 0023, and 0026-0029; see also Figure 1, element 12; Figure 2, steps 100 and 106; Figure 4, steps 200 and 206; and Figure 5, steps 300 and 306);
- b) determining select call setup requests from the call setup requests (Specification, paragraphs 0022-0024 and 0026-0029; see also Figure 2, steps 102, 108, and 122; Figure 4, steps 206 and 208; and Figure 5, steps 302 and 308), the select call setup requests being received from users who are authorized to initiate a call for emergency services (Specification, paragraphs 0023, 0024, 0027, and 0029; see also Figure 2, steps 108, 116, and 122; Figure 4, step 208; and Figure 5, step 308); and
- c) forwarding the select call setup requests toward at least one terminating device (Specification, paragraph 0014; see also Figure 1, element 14) associated with the emergency services (Specification, paragraphs 0023, 0027, and 0029; see also Figure 2, steps 114 and 118; Figure 4, step 214; and Figure 5, steps 314 and 318),

wherein one of the at least one originating or terminating devices resides on a packet network (Specification, paragraph 0014; see also Figure 1).

Claim 2, which depends from claim 1, recites that ones of the call setup requests that are not the select call setup requests are not forwarded toward the at least one terminating device (Specification, paragraphs 0022, 0024, and 0026; see also Figure 2, steps 102, 104, and 124; and Figure 4, steps 202 and 204).

Claim 10, which depends from claim 1, recites that forwarding the select call setup requests toward the at least one terminating device comprises sending the select call setup requests to a proxy (Specification, paragraph 0014; see also Figure 1, element 20) for the at least

one terminating device (Specification, paragraphs 0023 and 0029; see also Figure 2, step 114; and Figure 5, step 314).

Claim 11, which depends from claim 1, recites that the call setup requests are received over the packet network (Specification, paragraphs 0022-0024; see also Figure 2, steps 100, 106, and 120) and the select call setup requests are forwarded toward the at least one terminating device over the packet network (Specification, paragraph 0023; see also Figure 2, steps 114 and 118).

Claim 12, which depends from claim 1, recites that the call setup requests are received over the packet network (Specification, paragraphs 0026 and 0027; see also Figure 4, steps 200 and 206) and the select call setup requests are forwarded toward the at least one terminating device over a circuit-switched network (Specification, paragraph 0027; see also Figure 4, step 214).

Claim 13, which depends from claim 12, recites that the select call setup requests that are forwarded toward the at least one terminating device over the circuit-switched network are initial address messages (Specification, paragraph 0027).

Claim 15, which depends from claim 1, recites that the call setup requests are received over a circuit-switched network (Specification, paragraph 0028 and 0029; see also Figure 5, steps 300 and 306) and the select call setup requests are forwarded toward the at least one terminating device over the packet network (Specification, paragraphs 0015 and 0029; see also Figure 5, steps 314 and 318).

Claim 17, which depends from claim 15, recites that the select call setup requests forwarded toward the at least one terminating device are session initiation protocol INVITE messages (Specification, paragraph 0029).

Independent claim 18 recites a system for controlling access to emergency services comprising:

- a) at least one communication interface (Specification, paragraph 0031; see also Figure 6, element 30); and
- b) a control system (Specification, paragraph 0031; see also Figure 6, element 24) associated with the at least one communication interface and adapted to:
  - i) receive call setup requests from at least one originating device (Specification, paragraphs 0014, 0022, 0023, and 0026-0029; see also Figure 1, element

12; Figure 2, steps 100 and 106; Figure 4, steps 200 and 206; and Figure 5, steps 300 and 306);

ii) determine select call setup requests from the call setup requests (Specification, paragraphs 0022-0024 and 0026-0029; see also Figure 2, steps 102, 108, and 122; Figure 4, steps 206 and 208; and Figure 5, steps 302 and 308), the select call setup requests being received from users who are authorized to initiate a call for emergency services (Specification, paragraphs 0023, 0024, 0027, and 0029; see also Figure 2, steps 108, 116, and 122; Figure 4, step 208; and Figure 5, step 308); and

iii) forward the select call setup requests toward at least one terminating device (Specification, paragraph 0014; see also Figure 1, element 14) associated with the emergency services (Specification, paragraphs 0023, 0027, and 0029; see also Figure 2, steps 114 and 118; Figure 4, step 214; and Figure 5, steps 314 and 318),

wherein one of the at least one originating or terminating devices resides on a packet network (Specification, paragraph 0014; see also Figure 1).

Claim 19, which depends from claim 18, recites that ones of the call setup requests that are not the select call setup requests are not forwarded toward the at least one terminating device (Specification, paragraphs 0022, 0024, and 0026; see also Figure 2, steps 102, 104, and 124; and Figure 4, steps 202 and 204).

Claim 27, which depends from claim 18, recites that in order to forward the call setup requests toward the at least one terminating device, the control system is further adapted to send the select call setup requests to a proxy (Specification, paragraph 0014; see also Figure 1, element 20) for the at least one terminating device (Specification, paragraphs 0023 and 0029; see also Figure 2, step 114; and Figure 5, step 314).

Claim 28, which depends from claim 18, recites that the call setup requests are received over the packet network (Specification, paragraphs 0022-0024; see also Figure 2, steps 100, 106, and 120) and the select call setup requests are forwarded toward the at least one terminating device over the packet network (Specification, paragraph 0023; see also Figure 2, steps 114 and 118).

Claim 29, which depends from claim 18, recites that the call setup requests are received over the packet network (Specification, paragraphs 0026 and 0027; see also Figure 4, steps 200 and 206) and the select call setup requests are forwarded toward the at least one terminating

device over a circuit-switched network (Specification, paragraph 0027; see also Figure 4, step 214).

Claim 30, which depends from claim 29, recites that the select call setup requests that are forwarded toward the at least one terminating device over the circuit-switched network are initial address messages (Specification, paragraph 0027).

Claim 32, which depends from claim 18, recites that the call setup requests are received over a circuit-switched network (Specification, paragraph 0028 and 0029; see also Figure 5, steps 300 and 306) and the select call setup requests are forwarded toward the at least one terminating device over the packet network (Specification, paragraphs 0015 and 0029; see also Figure 5, steps 314 and 318).

Claim 34, which depends from claim 32, recites that the select call setup requests forwarded toward the at least one terminating device are session initiation protocol INVITE messages (Specification, paragraph 0029).

Independent claim 35 recites a tangible computer readable media (Specification, paragraph 0031; see also Figure 6, element 26) with software (Specification, paragraph 0031; see also Figure 6, element 28) for controlling access to emergency services, said software comprising instructions for a control system (Specification, paragraph 0031; see also Figure 6, element 24) to:

- a) receive call setup requests from at least one originating device (Specification, paragraphs 0014, 0022, 0023, and 0026-0029; see also Figure 1, element 12; Figure 2, steps 100 and 106; Figure 4, steps 200 and 206; and Figure 5, steps 300 and 306);

- b) determine select call setup requests from the call setup requests (Specification, paragraphs 0022-0024 and 0026-0029; see also Figure 2, steps 102, 108, and 122; Figure 4, steps 206 and 208; and Figure 5, steps 302 and 308), the select call setup requests being received from users who are authorized to initiate a call for emergency services (Specification, paragraphs 0023, 0024, 0027, and 0029; see also Figure 2, steps 108, 116, and 122; Figure 4, step 208; and Figure 5, step 308); and

- c) forward the select call setup requests toward at least one terminating device (Specification, paragraph 0014; see also Figure 1, element 14) associated with the emergency services (Specification, paragraphs 0023, 0027, and 0029; see also Figure 2, steps 114 and 118; Figure 4, step 214; and Figure 5, steps 314 and 318),

wherein one of the at least one originating or terminating devices resides on a packet network (Specification, paragraph 0014; see also Figure 1).

## **(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

**A.** Whether claims 1-5, 10-22, and 27-35 were properly rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,775,534 B2 to *Lindgren et al.* (hereinafter “*Lindgren*”).

**B.** Whether claims 6, 9, 23, and 26 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lindgren* in view of U.S. Patent No. 6,370,234 B1 to *Kroll* (hereinafter “*Kroll*”).

**C.** Whether claims 7, 8, 24, and 25 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lindgren* in view of U.S. Patent Application Publication No. 2007/0121590 A1 to *Turner et al.* (hereinafter “*Turner*”).

## **(7) ARGUMENT**

### **A. Introduction**

The Patent Office has not shown where all the elements of the pending claims are shown in the prior art with sufficient particularity to sustain an anticipation or an obviousness rejection. In particular, the Patent Office has not shown where the prior art discloses the feature of selecting call setup requests from a group of call setup requests, where the call setup requests that are selected from the group of call setup requests are those that are received from users who are authorized to initiate a call for emergency services. In addition, the Patent Office has not shown where the prior art discloses the feature of forwarding selected call setup requests toward a terminating device associated with emergency services. The Patent Office has not shown where the prior art discloses all of the features recited in the dependent claims. As such, the Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons along with the reasons noted below.

## **B. Summary Of References**

### **1. U.S. Patent No. 6,775,534 B2 To Lindgren**

*Lindgren* relates to allowing for the special treatment of emergency calls such that an emergency call will be successful.<sup>1</sup> *Lindgren* discloses that when a dialed number is received, a controller recognizes that the call is an emergency call.<sup>2</sup> After recognizing the emergency call, a sent activation request is handled accordingly.<sup>3</sup> A mobile unit sends first and second PDP activations, which each include an indication that the call is an emergency call, to a SGSN.<sup>4</sup> When the SGSN recognizes the received emergency call indication, the call setup process will not stop, even in the event that an unsuccessful authentication occurs.<sup>5</sup> Thus, according to *Lindgren*, all emergency call requests will be completed.<sup>6</sup> Nonetheless, *Lindgren* does not disclose, or even suggest, selecting call setup requests from a group of call setup requests, where the call setup requests that are selected from the group of call setup requests are those that are received from users who are authorized to initiate a call for emergency services. Furthermore, *Lindgren* does not disclose or suggest forwarding selected call setup requests toward a terminating device associated with emergency services.

### **2. U.S. Patent No. 6,370,234 B1 To Kroll**

*Kroll* discloses a public safety answering point that includes a central processing unit.<sup>7</sup> The central processing unit selects a call having a highest priority to send to an operator console.<sup>8</sup> Moreover, *Kroll* discloses that the central processing unit determines a time period since an emergency vehicle was last dispatched to a call area and uses the time period to determine that the call relates to a new incident based on the time period being greater than a predetermined period of time.<sup>9</sup> However, nowhere does *Kroll* disclose or suggest selecting call setup requests from a group of call setup requests, where the call setup requests that are selected from the group of call setup requests are those that are received from users who are authorized to

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<sup>1</sup> See *Lindgren*, col. 1, ll. 42-45.

<sup>2</sup> See *Lindgren*, col. 2, ll. 36-39.

<sup>3</sup> See *Lindgren*, col. 2, ll. 39-41.

<sup>4</sup> See *Lindgren*, col. 2, ll. 44-56.

<sup>5</sup> See *Lindgren*, col. 2, ll. 61-65.

<sup>6</sup> See *Lindgren*, col. 2, ll. 60-65.

<sup>7</sup> See *Kroll*, col. 4, ll. 57-59.

<sup>8</sup> See *Kroll*, col. 4, ll. 62-64.

<sup>9</sup> See *Kroll*, col. 4, l. 66 – col. 5, l. 3.

initiate a call for emergency services. In addition, *Kroll* does not disclose or suggest forwarding selected call setup requests toward a terminating device associated with emergency services.

### **3. U.S. Patent Application Publication No. 2007/0121590 A1 To *Turner***

*Turner* generally relates to call management services in a virtual private network (VPN) using voice or video over Internet protocol.<sup>10</sup> In particular, *Turner* discloses a telephone network system that provides call management services.<sup>11</sup> The telephone network system includes a call agent that receives a call request having a name and a number associated with a subscriber.<sup>12</sup> The telephone network system also includes a directory server that translates the name and number associated with the subscriber into a current network address associated with a physical location of the subscriber in a wired network.<sup>13</sup> In addition, the telephone network system includes a portability server that provides the subscriber's current network address to the directory server.<sup>14</sup> Nevertheless, *Turner* does not disclose or suggest selecting call setup requests from a group of call setup requests, where the call setup requests that are selected from the group of call setup requests are those that are received from users who are authorized to initiate a call for emergency services. Moreover, *Turner* does not disclose or suggest forwarding selected call setup requests toward a terminating device associated with emergency services.

## **C. Legal Standards**

### **1. The Standards For Establishing Anticipation**

Section 102 of the Patent Act provides the statutory basis for an anticipation rejection and states *inter alia*:

A person shall be entitled to a patent unless

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(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in

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<sup>10</sup> See *Turner*, paragraph [0001].

<sup>11</sup> See *Turner*, page 15, col. 2, ll. 6-7.

<sup>12</sup> See *Turner*, page 15, col. 2, ll. 8-11.

<sup>13</sup> See *Turner*, page 15, col. 2, ll. 12-16.

<sup>14</sup> See *Turner*, page 15, col. 2, ll. 17-18.



the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. . . .

The Federal Circuit's test for anticipation has been set forth numerous times. "It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention."<sup>15</sup> This standard has been reinforced. "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."<sup>16</sup> Further, "a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device."<sup>17</sup>

## **2. The Standards For Establishing Obviousness**

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.<sup>18</sup>

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. "Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demand known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion

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<sup>15</sup> *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986).

<sup>16</sup> *PPG Indus. Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1577 (Fed. Cir. 1996) (citations omitted).

<sup>17</sup> *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998) (emphasis added and citations omitted).

<sup>18</sup> *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 45 U.S.P.Q.2d (BNA) 1977, 1981 (Fed. Cir. 1998) (internal citations omitted).

claimed by the patent at issue. To facilitate review, this analysis should be made explicit.<sup>19</sup> (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).<sup>20</sup>

Some elements may be inherent within the reference. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’”<sup>21</sup> “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”<sup>22</sup> Thus, the possibility that an element may be derived from the reference is insufficient to establish that said element is inherent to the reference.

Whether an element is implicitly or explicitly taught by a reference or combination of references is open to interpretation. While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification.<sup>23</sup> Second, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.<sup>24</sup> Finally, the interpretation must be reasonable.<sup>25</sup> This means that the words of the claim must be given their plain meaning unless Appellant has provided a clear definition in the specification.<sup>26</sup>

If a claim element is missing after the combination is made, then the combination does not render obvious the claimed invention, and the claims are allowable. As stated by the Federal Circuit, “[if] the PTO fails to meet this burden, then the Appellant is entitled to the patent.”<sup>27</sup>

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<sup>19</sup> See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)

<sup>20</sup> *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007).

<sup>21</sup> *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (quoting *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991)).

<sup>22</sup> *Ibid.* (citation and quotation omitted).

<sup>23</sup> *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); M.P.E.P. § 2111.

<sup>24</sup> *In re Cortright*, 165 F.3d 1353, 1359, (Fed. Cir. 1999); M.P.E.P. § 2111.

<sup>25</sup> *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); M.P.E.P. § 2111.01.

<sup>26</sup> *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

<sup>27</sup> *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

**D. Claim 1-5, 10-22, And 27-35 Are Not Anticipated By *Lindgren***

Claims 1-5, 10-22, and 27-35 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Lindgren*. The Appellant respectfully traverses the rejection.

**1. *Lindgren* Does Not Disclose Selecting Call Setup Requests From A Group Of Call Setup Requests, Where The Call Setup Requests That Are Selected From The Group Of Call Setup Requests Are Those That Are Received From Users Who Are Authorized To Initiate A Call For Emergency Services**

Prior to addressing the rejection, the Appellant provides a brief summary of one embodiment of the present invention. Here, an originating element attempts to initiate an emergency call with a terminating element by sending a call setup request to an emergency proxy.<sup>28</sup> According to this embodiment, the emergency proxy determines if the call setup request meets the emergency criteria of an emergency call setup request.<sup>29</sup> In particular, the emergency proxy will authenticate the call setup request to ensure that the originating element can initiate a request for an emergency call.<sup>30</sup> If the originating element is unauthorized to establish an emergency call, the emergency proxy will not forward the call setup request.<sup>31</sup> On the other hand, if the emergency proxy determines that an authorized originating element has sent the call setup request, the emergency proxy will alter the call setup request and forward the request towards the terminating element. The Appellant submits that *Lindgren* does not disclose determining if a call setup request is received from a user authorized to initiate a call for emergency services and then forwarding the call setup request towards a terminating device.

Instead, *Lindgren* discloses that all emergency calls will be forwarded, regardless of who is originating the call.<sup>32</sup> In particular, *Lindgren* discloses that if a SGSN recognizes that a call is for emergency services, the SGSN will not stop the call, even if an unsuccessful authentication occurs.<sup>33</sup> Thus, if anything, *Lindgren* discloses the exact opposite of what the Appellant is claiming.

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<sup>28</sup> See Specification, paragraphs [0015] and [0022], see also Figure 2, step 100.

<sup>29</sup> See Specification, paragraphs [0015] and [0022], see also Figure 2, step 102.

<sup>30</sup> See Specification, paragraph [0016].

<sup>31</sup> See Specification, paragraph [0022]; see also Figure 2, steps 102 and 104.

<sup>32</sup> See *Lindgren*, col. 2, ll. 60-65.

<sup>33</sup> See *Lindgren*, col. 2, ll. 60-65.

Now turning to the rejection, according to Chapter 2131 of the M.P.E.P., in order to anticipate a claim under 35 U.S.C. § 102, “the reference must teach every element of the claim.” The Appellant submits that *Lindgren* does not teach every element recited in claims 1-5, 10-22, and 27-35. More specifically, claim 1 recites a method for controlling access to emergency services comprising, among other features, “determining select call setup requests from the call setup requests, the select call setup requests being received from users who are authorized to initiate a call for emergency services.” Claims 18 and 35 include similar features. The Appellant submits that *Lindgren* does not disclose, or even suggest, selecting call setup requests from a group of call setup requests, where the call setup requests that are selected from the group of call setup requests are those that are received from users who are authorized to initiate a call for emergency services. The Patent Office supports the rejection by stating that *Lindgren* discloses this feature in col. 3, ll. 6-16, in col. 4, ll. 18-21, and in col. 5, ll. 12-22.<sup>34</sup> The Appellant respectfully disagrees.

With reference to col. 3, ll 6-16 and col. 5, ll. 12-22 of *Lindgren*, at most, the cited portions disclose that a GGSN determines the identity of a local geographical VoIP server that should receive call control signals from a mobile terminal.<sup>35</sup> However, nowhere does the cited portion disclose, or even suggest, selecting call setup requests from a group of call setup requests, where the call setup requests that are selected are those that are received from users who are authorized to initiate a call for emergency services. Regarding col. 4, ll. 18-21, at most, the cited portion discloses that if a mobile station does not have a Subscriber Identity Module (SIM) card, then it is not possible for the mobile unit to make a call.<sup>36</sup> However, this simply relates to the inoperability of a mobile unit and not whether or not an originating device is authorized to initiate a call for emergency services.

Moreover, as detailed above, *Lindgren* discloses allowing the completion of a call for emergency services, regardless of the originator. In fact as previously mentioned, *Lindgren* explicitly discloses that even if an originator has not been authenticated, the emergency call will be completed. This, *Lindgren* discloses the exact opposite of what is being claimed. The Appellant also has reviewed the remaining portions of the cited reference and submits that nowhere does *Lindgren* disclose, or even suggest, selecting call setup requests from a group of

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<sup>34</sup> See Final Office Action mailed September 9, 2008, page 4.

<sup>35</sup> See *Lindgren*, col. 3, ll. 7-10.

<sup>36</sup> See *Lindgren*, col. 4, ll. 19-22.

call setup requests, where the call setup requests that are selected are those that are received from users who are authorized to initiate a call for emergency services. At the very most, *Lindgren* discloses receiving a call for emergency services.<sup>37</sup>

**2. *Lindgren* Does Not Disclose Forwarding Selected Call Setup Requests Toward A Terminating Device Associated With Emergency Services**

Claim 1 also recites “forwarding the select call setup requests toward at least one terminating device associated with the emergency services.” Claims 18 and 35 include similar features. The Appellant submits that *Lindgren* does not disclose, or even suggest, forwarding selected call setup requests toward a terminating device associated with emergency services. As detailed above, *Lindgren* does not disclose selecting call setup requests as recited in the claims. Accordingly, it follows that *Lindgren* cannot disclose forwarding call setup requests, which have been selected from a group of call setup requests, toward a terminating device associated with emergency services. For this reason and the reasons noted above, claims 1, 18, and 35 are patentable over *Lindgren*. Similarly, claims 3-5, 14, 16, 20-22, 31, and 33, which variously depend from claim 1 or 18, are patentable for at least the same reasons along with the novel features recited therein.

**3. *Lindgren* Does Not Disclose That Ones Of The Call Setup Requests That Are Not The Selected Call Setup Requests Are Not Forwarded Toward A Terminating Device**

Claim 2, which depends from claim 1, recites that “ones of the call setup requests that are not the select call setup requests are not forwarded toward the at least one terminating device.” Claim 19, which depends from claim 18, includes similar features. The Appellant submits that *Lindgren* does not disclose that ones of the call setup requests that are not the selected call setup requests are not forwarded toward a terminating device. The Patent Office supports the rejection by stating that *Lindgren* discloses this feature in col. 4, ll. 18-21.<sup>38</sup> The Appellant respectfully disagrees. At most, the cited portion discloses that when a mobile station does not include a SIM card, a call may not be initiated.<sup>39</sup> However, the cited portion of *Lindgren* makes no mention of call setup requests that are not selected. In addition, the cited portion of *Lindgren* fails to

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<sup>37</sup> See *Lindgren*, col. 2, ll. 36-41.

<sup>38</sup> See Office Action mailed March 11, 2008, page 3.

<sup>39</sup> See *Lindgren*, col. 4, ll. 20-22.

disclose that call setup requests that are not selected are not forwarded toward a terminating device. Furthermore, as noted above, *Lindgren* explicitly discloses forwarding all call setup requests, which is the exact opposite of not forwarding call setup requests that have not been selected. Thus, in addition to the reasons noted above with reference to claims 1 and 18, claims 2 and 19 are patentable over *Lindgren*.

**4. *Lindgren* Does Not Disclose Sending Selected Call Setup Requests To A Proxy Of A Terminating Device**

Claim 10, which depends from claim 1, recites “sending the select call setup requests to a proxy for the at least one terminating device.” Claim 27, which depends from claim 18, includes similar features. The Appellant submits that *Lindgren* does not disclose sending selected call setup requests to a proxy for a terminating device. As discussed above, *Lindgren* mentions nothing about selected call setup requests, much less sending them to a terminating device. Thus, *Lindgren* cannot disclose sending selected call setup requests to a proxy of a terminating device. For at least this reason and the reasons noted above with reference to claims 1 and 18, claims 10 and 27 are patentable over the cited references.

**5. *Lindgren* Does Not Disclose That Select Call Setup Requests Are Forwarded Toward A Terminating Device Over A Packet Network**

Claim 11, which depends from claim 1, recites that “select call setup requests are forwarded toward the at least one terminating device over the packet network.” Claim 15, which also depends from claim 1, and claims 28 and 32, which depend from claim 18, include similar features. The Appellant submits that *Lindgren* does not disclose that select call setup requests are forwarded toward a terminating device over a packet network. As previously mentioned, *Lindgren* does not disclose selecting call setup requests as recited in the claims. Accordingly, *Lindgren* cannot disclose that selected call setup requests are forwarded toward a terminating device, nor that the selected call setup requests are forwarded toward a terminating device over a packet network. In addition to the reasons noted above with reference to claims 1 and 18, claims 11, 15, 28, and 32 are patentable over the cited reference.

**6. *Lindgren* Does Not Disclose That Selected Call Setup Requests Are Forwarded Toward A Terminating Device Over A Circuit-Switched Network**

Claim 12, which depends from claim 1, recites that “select call setup requests are forwarded toward the at least one terminating device over a circuit-switched network.” Claim 29, which depends from claim 18, includes similar features. The Appellant submits that *Lindgren* does not disclose that selected call setup requests are forwarded toward a terminating device over a circuit-switched network. As outlined above, *Lindgren* does not disclose forwarding selected call setup requests toward a terminating device. Thus, it follows that *Lindgren* cannot disclose that selected call setup requests are forwarded toward a terminating device over a circuit-switched network. In addition to the reasons noted above with reference to claims 1 and 18, claims 12 and 29 are patentable over the cited reference.

**7. *Lindgren* Does Not Disclose That Selected Call Setup Requests Forwarded Toward A Terminating Device Over A Circuit-Switched Network Are Initial Address Messages**

Claim 13, which ultimately depends from claim 1, recites that “the select call setup requests forwarded toward the at least one terminating device over the circuit-switched network are initial address messages.” Claim 30, which depends from claim 18, includes similar features. The Appellant submits that *Lindgren* does not disclose that selected call setup requests forwarded toward a terminating device over a circuit-switched network are initial address messages. As detailed above, *Lindgren* does not disclose forwarding call setup requests toward a terminating device over a circuit-switched network. Thus, it follows that *Lindgren* cannot disclose that selected call setup requests forwarded toward a terminating device over a circuit-switched network are initial address messages. For this reason and the reasons noted above with respect to claims 1 and 18, claims 13 and 30 are patentable over the cited reference.

**8. *Lindgren* Does Not Disclose That Selected Call Setup Requests Forwarded Toward A Terminating Device Are Session Initiation Protocol INVITE Messages**

Claim 17, which depends from claim 15, recites that the “select call setup requests forwarded toward the at least one terminating device are session initiation protocol INVITE messages.” Claim 34, which depends from claim 32, includes similar features. The Appellant

submits that *Lindgren* does not disclose that selected call setup requests forwarded toward a terminating device are session initiation protocol INVITE messages. As detailed above, *Lindgren* does not disclose forwarding selected call setup requests toward a terminating device. Thus, *Lindgren* cannot disclose that select call setup requests forwarded toward a terminating device are session initiation protocol INVITE messages. For this reason and the reasons noted above with respect to claims 15 and 32, claims 17 and 34 are patentable over the cited reference.

#### **E. Claims 6, 9, 23, And 26 Are Patentable Over *Lindgren* In View Of *Kroll***

Claims 6, 9, 23, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lindgren* in view of U.S. Patent No. 6,370,234 B1 to *Kroll* (hereinafter “*Kroll*”). The Appellant respectfully traverses the rejection. When rejecting a claim under 35 U.S.C. § 103, the Patent Office must either show that the prior art references teach or suggest all limitations of the claim or explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.<sup>40</sup> The gap between the prior art and the claimed invention may not be “so great as to render the [claim] nonobvious to one reasonably skilled in the art.”<sup>41</sup> Here, the Patent Office has failed to show where each and every limitation of the claims is taught or suggested by the prior art. Further, for those limitations of the claims that are not taught or suggested by the prior art, the Patent Office has failed to explain why those limitations would have been obvious to one of ordinary skill in the art. The Appellant submits that neither *Lindgren* nor *Kroll*, either alone or in combination, discloses or suggests all the features recited in claims 6, 9, 23, and 26. As detailed above, claims 1 and 18, the base claims from which claims 6, 9, 23, and 26 variously depend, are patentable over *Lindgren*. Moreover, *Kroll* does not address the previously noted problems of *Lindgren*. Therefore, claims 6, 9, 23, and 26 are patentable over the cited references.

#### **F. Claims 7, 8, 24, And 25 Are Patentable Over *Lindgren* In View Of *Turner***

Claims 7, 8, 24, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lindgren* in view of U.S. Patent Application Publication No. 2007/0121590 A1 to *Turner et*

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<sup>40</sup> Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*, published in the Federal Register, Vol. 72, No. 195, pages 57526-57535.

<sup>41</sup> *Dann v. Johnston*, 425 U.S. 219, 230, 189 U.S.P.Q. (BNA) 257, 261 (1976).



*al.* (hereinafter “*Turner*”). The Appellant respectfully traverses the rejection. Regarding claims 8 and 25, as shown above, claims 1 and 18, the base claims from which claims 8 and 25 respectively depend are patentable over *Lindgren*. Furthermore, *Turner* does not overcome the previously discussed shortcomings of *Lindgren*. As such, claims 8 and 25 are patentable over the cited references.

**1. Neither *Lindgren* Nor *Turner*, Either Alone Or In Combination, Discloses Or Suggests That Selected Call Setup Requests Are Sent Toward A Terminating Device When The Terminating Device Is In An Overload Condition**

Claim 7 recites that “the select call setup requests are sent toward the at least one terminating device when the at least one terminating device is in an overload condition.” Claim 24, which depends from claim 18, includes similar features. The Appellant submits that neither *Lindgren* nor *Turner*, either alone or in combination, discloses or suggests that selected call setup requests are sent toward a terminating device when the terminating device is in an overload condition. As detailed above, *Lindgren* does not disclose, or even suggest forwarding selected call setup requests toward a terminating device. Likewise, *Turner* does not disclose this feature. Thus, it follows that neither reference, either alone or in combination, can disclose or suggest that selected call setup requests are sent toward a terminating device when the terminating device is in an overload condition. For at least this reason, claims 7 and 24 are patentable over *Lindgren* and *Turner*.

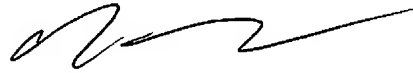
**G. Conclusion**

As set forth above, the cited references do not disclose the feature of selecting call setup requests from a group of call setup requests, where the call setup requests that are selected from the group of call setup requests are those that are received from users who are authorized to initiate a call for emergency services. In addition, the Patent Office has not shown where the prior art discloses the feature of forwarding selected call setup requests toward a terminating device associated with emergency services. The Patent Office also has not shown where the prior art discloses all of the features recited in the dependent claims. As such, the Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

Respectfully submitted,

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## **(8) CLAIMS APPENDIX**

1. A method for controlling access to emergency services comprising:
  - a) receiving call setup requests from at least one originating device;
  - b) determining select call setup requests from the call setup requests, the select call setup requests being received from users who are authorized to initiate a call for emergency services; and
  - c) forwarding the select call setup requests toward at least one terminating device associated with the emergency services,  
wherein one of the at least one originating or terminating devices resides on a packet network.
2. The method of claim 1 wherein ones of the call setup requests that are not the select call setup requests are not forwarded toward the at least one terminating device.
3. The method of claim 1 further comprising:
  - a) creating emergency information for each of the select call setup requests; and
  - b) inserting the emergency information into the select call setup requests prior to forwarding the select call setup requests toward the at least one terminating device.
4. The method of claim 3 wherein the emergency information is provided in an emergency header field of the select call setup requests.
5. The method of claim 3 wherein the emergency information inserted into the select call setup requests is encrypted.
6. The method of claim 1 further comprising selecting a priority level from a plurality of priority levels for each of the select call setup requests and inserting the selected priority levels into corresponding ones of the select call setup requests.
7. The method of claim 1 wherein the select call setup requests are sent toward the at least one terminating device when the at least one terminating device is in an overload condition.

8. The method of claim 1 wherein the call setup requests are sent toward the at least one terminating device when network elements involved in forwarding the call setup requests are in an overload condition.
9. The method of claim 1 wherein the call setup requests are processed with a higher priority by any network element that receives them.
10. The method of claim 1 wherein forwarding the select call setup requests toward the at least one terminating device comprises sending the select call setup requests to a proxy for the at least one terminating device.
11. The method of claim 1 wherein the call setup requests are received over the packet network and the select call setup requests are forwarded toward the at least one terminating device over the packet network.
12. The method of claim 1 wherein the call setup requests are received over the packet network and the select call setup requests are forwarded toward the at least one terminating device over a circuit-switched network.
13. The method of claim 12 wherein the select call setup requests forwarded toward the at least one terminating device over the circuit-switched network are initial address messages.
14. The method of claim 12 wherein the call setup requests are session initiation protocol INVITE messages.
15. The method of claim 1 wherein the call setup requests are received over a circuit-switched network and the select call setup requests are forwarded toward the at least one terminating device over the packet network.
16. The method of claim 15 wherein the call setup requests are initial address messages.

17. The method of claim 15 wherein the select call setup requests forwarded toward the at least one terminating device are session initiation protocol INVITE messages.

18. A system for controlling access to emergency services comprising:

- a) at least one communication interface; and
- b) a control system associated with the at least one communication interface and adapted to:
  - i) receive call setup requests from at least one originating device;
  - ii) determine select call setup requests from the call setup requests, the select call setup requests being received from users who are authorized to initiate a call for emergency services; and
  - iii) forward the select call setup requests toward at least one terminating device associated with the emergency services,wherein one of the at least one originating or terminating devices resides on a packet network.

19. The system of claim 18 wherein ones of the call setup requests that are not the select call setup requests are not forwarded toward the at least one terminating device.

20. The system of claim 18 wherein the control system is further adapted to:

- a) create emergency information for each of the select call setup requests; and
- b) insert the emergency information into the select call setup requests prior to forwarding the select call setup requests toward the at least one terminating device.

21. The system of claim 20 wherein the emergency information is provided in an emergency header field of the select call setup requests.

22. The system of claim 20 wherein the emergency information inserted into the select call setup requests is encrypted.

23. The system of claim 18 wherein the control system is further adapted to select a priority level from a plurality of priority levels for each of the select call setup requests and insert the selected priority levels into corresponding ones of the select call setup requests.
24. The system of claim 18 wherein the select call setup requests are sent toward the at least one terminating device when the at least one terminating device is in an overload condition.
25. The system of claim 18 wherein the call setup requests are sent toward the at least one terminating device when network elements involved in forwarding the call setup requests are in an overload condition.
26. The system of claim 18 wherein the call setup requests are processed with a higher priority by any network element that receives them.
27. The system of claim 18 wherein to forward the call setup requests toward the at least one terminating device, the control system is further adapted to send the select call setup requests to a proxy for the at least one terminating device.
28. The system of claim 18 wherein the call setup requests are received over the packet network and the select call setup requests are forwarded toward the at least one terminating device over the packet network.
29. The system of claim 18 wherein the call setup requests are received over the packet network and the select call setup requests are forwarded toward the at least one terminating device over a circuit-switched network.
30. The system of claim 29 wherein the select call setup requests forwarded toward the at least one terminating device over the circuit-switched network are initial address messages.
31. The method of claim 29 wherein the call setup requests are session initiation protocol INVITE messages.

32. The system of claim 18 wherein the call setup requests are received over a circuit-switched network and the select call setup requests are forwarded toward the at least one terminating device over the packet network.
33. The system of claim 32 wherein the call setup requests are initial address messages.
34. The system of claim 32 wherein the select call setup requests forwarded toward the at least one terminating device are session initiation protocol INVITE messages.
35. A tangible computer readable media with software for controlling access to emergency services, said software comprising instructions for a control system to:
- a) receive call setup requests from at least one originating device;
  - b) determine select call setup requests from the call setup requests, the select call setup requests being received from users who are authorized to initiate a call for emergency services; and
  - c) forward the select call setup requests toward at least one terminating device associated with the emergency services,
- wherein one of the at least one originating or terminating devices resides on a packet network.

**(9) EVIDENCE APPENDIX**

The Appellant relies on no evidence, thus this appendix is not applicable.



**(10) RELATED PROCEEDINGS APPENDIX**

As there are no related proceedings, this appendix is not applicable.